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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/751,630  
Filing Date: December 29, 2000  
Appellant(s): WALTER, JOANNE S.

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Paul W. Martin  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 21, 2008 appealing from the Office action mailed August 20, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Siegel et al.: US Pub. No. 2002/00915262 A1

Stepanek, Marcia. Protecting E-Privacy: Washington Must Step In". Business Week, New York: July 26, 1999. Iss. 3639; pg. EB30.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No. US 2002/0091562 A1 to Siegel et al. (further referred to as Siegel), and further in view of "Protecting E-Privacy: Washington Must Step In" by Marcia Stepanek (further referred to as Stepanek).

Regarding claims 21-22, Siegel discloses a method for prescribing personal data preferences (page 1, paragraph 7) comprising the steps of:

a) coupling an electronic consumer device to a computer of a business (page 2, paragraphs 13 and 22-23);

b) accessing a personal data preferences program executed by the computer through use of the electronic consumer device that enables a consumer to create a personal privacy profile choosing, selecting, and then assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business for the purpose of identifying and limiting the discrete types of data the business is authorized, by the customer's choice of opt in, to collect, use, and disseminate in accordance with the personal privacy profile data type options selected as opt in by the customer (page 1, paragraph 7; page 2, paragraphs 13 and 23);

c) recording consumer selection of the privacy options via the consumer device by the computer (page 2, paragraphs 13 and 22-23);

d) coding selected privacy options by the computer (page 2, paragraph 24; page 3, paragraph 35);

e) downloading coded privacy options to the consumer device by the computer (page 2, paragraph 24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

f) transferring the coded privacy options to a consumer storage medium separate from the consumer device by the computer (page 2, paragraphs 23-24; page 3, paragraphs 33-34; page 4, paragraphs 41-42; page 5, paragraph 44);

g) reading the coded privacy options from the consumer storage medium by a transaction computer during a transaction between the consumer and the business (page 2, paragraphs 13 and 23-24); and

h) limiting the collection, use, and dissemination of the personal data by the transaction computer in accordance with the coded privacy options (page 1, paragraphs 7 and 12; page 4, paragraph 39; page 5, paragraph 44).

Siegel discloses where the information gathered includes but is not limited to the data types of history of purchases from the business by the consumer, demographic data, amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (page 1, paragraph 12; page 2, paragraphs 14 and 23-24; page 3, paragraph 35; page 4, paragraphs 39-43; page 5, paragraph 44).

Siegel does not disclose where consumers may opt out of having this information

collected. However, Stepanek discloses where consumers may opt out of having this information collected (pages 1-2). It would be obvious to one of ordinary skill in the art to modify the privacy options for data collection with opt out feature for collection of personal data as disclosed by Siegel to adapt the use of opting out of purchase data collection as disclosed by Stepanek. The motivation would be that purchase information is another form of personal data (as it indicates interests and shopping patterns, etc.) and users may not want this information collected and stored by a merchant, such as is stated by Stepanek.

Siegel does not disclose where the electronic consumer device is coupled to a computer of a business selling goods or services, where the business selling goods or services provides a personal data preferences program on the coupled computer. However, Stepanek discloses where the consumer is connected to a business offering the personal preferences program (pages 1-2). It would be obvious to one of ordinary skill in the art to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Regarding claims 23-24, Siegel discloses the method wherein the consumer device is one of a personal computer or a personal digital assistance (page 2, paragraph 13 and 22-24; page 3, paragraph 34).

Regarding claim 26, Siegel does not disclose recording privacy preferences of a customer via a self-service terminal of the seller [incorrectly stated as page 4, paragraph 40; rejection is according to rejection of claim 1 regarding a seller terminal].

#### **(10) Response to Argument**

The Appellant's arguments have been considered but are not persuasive.

The Siegel and Stepanek references relate to the exchange of customer personal data during transactions. Siegel discloses that customers prefer to exercise control on the use of identifying information, limiting private information available to third parties linking his identify to his purchases (page 1, paragraph 7). Siegel discloses where the consumer gains the convenience of electronic communication of selected information while maintaining control over personal information (page 5, paragraph 44). While Siegel does not disclose the ability to opt-out of data collection, as discussed in the rejected claims above, Stepanek discloses where a business offers an opt-out policy for customers, recognizing that some customers do not want personal information collected and that the goodwill gained from honoring this wish results in customer loyalty (pages 1-2).

It would be obvious to adapt the use of maintaining the personal preference program at any phase in the consumer transaction process. Whether the limitation on information gathering is directed to an online advertising business or a business offering products for sale, the limitation on information gathering is stipulated. The motivation of adhering to a customer's wish for limiting data gathering at any point during the transaction by any interested parties would be that the personal preference programming offers the business a way to build customer trust and loyalty and therefore consumers would be more likely to return to this trusted source for future purchasing needs knowing their personal preferences regarding data collection would be honored and respected.

Applicant argues that the "Two methods of limiting customer information are different, because limits are set and enforced by different entities, Siegel with an EIA facilitator and Applicant with a seller of goods." However, examiner again points out that the limitation on information gathering is stipulated and disclosed by Siegel. And additionally the limitation on gathering and opting out of information gathering is stipulated and disclosed by Stepanek.

Applicant argues that neither Siegel nor Stepanek "discloses assigning opt in or opt out privacy options to one or more specific, distinct, and different types of personal data collected and maintained by the business ... ". However, as detailed in the rejection above, Siegel discloses where a accessing personal data preferences for the controlling of that data (paragraphs 7, 13, 22-23) and where the information gathered includes but is not limited to the data types of history of purchases, demographic data,



amount purchased, frequency of purchase, coupon used, payment method used, time of day, week, and year purchased (paragraphs 12, 14, 23-24, 35, 39-43, 44). While Siegel does not disclose the opting out of having this data collected, Stepanek discloses where consumers can opt out of having personal data collected while conducting a transaction with a seller. As set forth in the rejection above, it would be obvious that if it is known to gather specific and distinct types of data, and it is known for a consumer to opt out of having data collected, that the specific and distinct types of data which can be collected could be assigned to be opted from being collected.

In response to Applicant's argument that it would not have been obvious to modify the cited prior art reference(s) to create the claimed invention, the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR Int'l Co. v. Teleflex, Inc.* 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

In the instant case, the cited prior art references were available in the field at the time of the purported invention. The Applicant merely implemented a predictable variation of these existing methods in establishing his/her own invention. Such predicatability is based upon the fact that each incorporated method performs the same

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function and provides the same utility as originally intended in their pre-combination state.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jennifer Liversedge/

Examiner, Art Unit 3692

Conferees:

/Kambiz Abdi/

Supervisory Patent Examiner, Art Unit 3692

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